

Applicant: John E. Stockenberg, *et al.*

U.S.S.N.: 09/052,325

Filing Date: March 31, 1998

EMC Docket No.: EMC-97-137

Amendments to the Drawings:

The attached replacement sheets include Figs. 1-7. No changes have been made to the drawings. However, in response to the examiner's request for a new set of drawings, applicants are filing a complete set of drawings.

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REMARKS/ARGUMENTS

In response to the final Office Action mailed March 11, 2005, the applicants respectfully request reconsideration and entrance of the foregoing amendment. In the Office Action, claims 1-20 were rejected. Amendments to claims 1 and 17 have been presented. Accordingly, upon entrance of this amendment, claims 1-20 will remain pending in this application.

Rejection Under 35 U.S.C. §112

Claim 17 was rejected under 35 U.S.C. §112, second paragraph, as being indefinite. By this amendment, an amendment to claim 17 has been presented which addresses the rejection. Applicants assert that the amendment to claim 17 renders the rejection moot.

Accordingly, applicants assert that claim 17 is definite and that the rejection under 35 U.S.C. §112 should be withdrawn.

Drawing Objections

The examiner has required new corrected drawings, stating that, because of a scanning problem with the electronic file, figures 1, 2, 4, 4A and 5-7 do not have legible labels on the drawing figures or numbers for parts of the drawing.

Since applicants have only file hard copies of the drawings in this application, any scanning problems would have taken place at the U.S. Patent & Trademark Office. Accordingly, the hard copies filed by the applicants should be in the Patent Office file. Nonetheless, applicants have submitted herewith a new set of drawings including Figures 1-7.

Rejection Under 35 U.S.C. §103

Claims 1-20 remain rejected under 35 U.S.C. §103(a) as being unpatentable over various combinations of Yanai, Ofek and Ji. Based on the arguments set forth in previous responses and the following arguments, this rejection is traversed.

Applicants will address each of the issues raised by the examiner in support of the examiner's position in response to the applicants' previous response.

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Issue No. 1: Applicants have argued that there is no motivation to combine the references as suggested by the examiner. In addressing this argument, the examiner has simply repeated the claim language and stated that Yanai or Ofek teach certain portions of the claimed invention. There is absolutely no support in the examiner's argument for the position that there is a motivation to combine the references.

Without a motivation to combine, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Issue No. 2: Applicants have argued that Yanai does not teach a system having first and second processes residing on first and second computers, the first and second processes being used with at least one of backup and restore operations, wherein each of said first and said second computers are in communication with both a data storage system which stores data from at least said first and second computers and a network. Applicants also argued that the examiner has not pointed out the first and second computers taught by Yanai that have first and second processes or that are in communication with both a data storage system which stores data from at least said first and second computers and a network. In response to this argument, the examiner again refers to broad passages in the Background section of the patent and provides a broad reference to Fig. 1, but the examiner has yet to specifically indicate where Yanai teaches the elements recited in the claims.

Since Yanai does not teach the elements recited in the claims, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Issue No. 3: Applicants have argued that Yanai does not teach at least one first communication mechanism residing on each of the first and second computers for facilitating communications between the first and second processes that are each used with backup or restore operations over the network and a second communication mechanism residing on each of the first and second computers for facilitating communication between the first and second processes through the data storage system. In response to this argument, the examiner again refers to broad passages in

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the Specification and provides a list of connections between elements in Fig. 1, but the examiner has yet to specifically indicate where Yanai teaches the elements recited in the claims.

Since Yanai does not teach the elements recited in the claims, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Issue No. 4: Applicants have argued that there is no teaching or suggestion in the cited references of communication over a network as well as communication through a data storage system between two systems, as recited in the claims. In response to this argument, the examiner states that these features are not recited in the rejected claims. However, it is clear from claim 1 that this feature is indeed recited in the claim. Specifically, claim 1 recites, among other features:

...at least one first communication mechanism residing on each of said first and second computers for facilitating communications between said first and second processes, that are each used with backup or restore operations, over said network;

a second communication mechanism residing on each of said first and second computers for facilitating communication between said first and second processes through said data storage system....

Independent claims 6, 15 and 17 also recite this feature, among others. Accordingly, the feature upon which applicants' argument relies is recited in the claims.

Issue No. 5: Applicants have argued that Ofek teaches only one connection between the local system 10 and the remote system 11, there is no second connection and, specifically, no second connection through a data storage system. In response to this argument, the examiner seems to support the applicants' position by stating that Ofek teaches a communications link 12 that interconnects the local system 10 and the remote system 11. That is only one connection. There are no others.

Since Ofek does not teach the elements recited in the claims, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

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Issue No. 6: Applicants have argued that, even if the references were combined, the combination would not teach the invention recited claim 17. In response to this argument, the examiner refers to Issue No. 1 and states that there is no need to readdress this issue. Applicants agree, as it is clear that, based on applicants' arguments set forth above, the combination relied upon by the examiner does not teach the invention recited in claim 17.

Since the combination relied upon by the examiner does not teach the elements recited in the claim, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Issue No. 7: Applicants have argued that Yanai, Ofek and Ji do not teach or suggest the invention claimed in claim 6, alone or in combination, because there is no motivation to combine the references. In response to this argument, the examiner refers to Issue No. 1 and states that there is no need to readdress this issue. Applicants agree, as it is clear that, based on applicants' arguments set forth above, the combination relied upon by the examiner does not teach the invention recited in claim 6.

Since the combination relied upon by the examiner does not teach the elements recited in the claim, the 35 U.S.C. §103(a) rejections are improper and should be withdrawn.

Regarding the motivation to combine, the examiner states that the rationale may be in a reference or reasoned from common knowledge in the art, scientific principles, art-recognized equivalents, or legal precedent. Furthermore, the examiner states that a correspondence was carefully drawn by the examiner between the applicants' claim limitations and one or more referenced passages in the references, what is well-known in the art, and what is known to one having ordinary skill in the art.

Applicants respectfully disagree. A thorough review of the prosecution history of this application shows that, throughout the prosecution, the examiner has repeated the language recited in the claims and referred to broad passages of the references and/or entire figures. No element-for-element comparison between what is claimed and what is shown in the references has been provided, no basis or rationale for the motivation to combine the references has been provided, and no support for what is well-known in the art or to one of ordinary skill in the art has been provided.

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Applicants have made every effort to analyze each reference and to provide a well-reasoned basis for the applicants' position that the claims are allowable over the references. This is reflected in the prosecution history.

Accordingly, applicants again assert that claims 1-20 are allowable over the art of record.

Finally, the examiner has stated that:

There are outstanding 35 U.S.C. 112, second paragraph issues with the claims as addressed above which need clarification in the claim language and Applicants need to particularly point out and to claim the novel feature of their invention in their independent claims. Where is this feature claimed in claims 1, 6, 15 and 17?

Applicants assume that the 35 U.S.C. 112, second paragraph issues that the examiner refers to is the rejection of claim 17, since there is no other specific rejection of claims under 35 U.S.C. 112, second paragraph. By this amendment, applicants have rendered the rejection moot.

Regarding the examiner's query as to the novel feature of the invention, applicants respectfully assert that, after 7 years of prosecution, what applicants believe to be the novel feature of the invention should be clear. Every 35 U.S.C. 112, second paragraph rejection has been addressed, seemingly to the satisfaction of the examiner. Therefore, applicants assert that the novel feature(s) of the invention is/are particularly pointed out and distinctly claimed in the pending claims.

In view of the foregoing, the applicants' believe that the application is in condition for allowance and respectfully request favorable reconsideration.

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In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at (508) 293-7835.

Please charge all fees occasioned by this submission to Deposit Account No. 05-0889.

Respectfully submitted,

Dated: _____

4/13/05



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